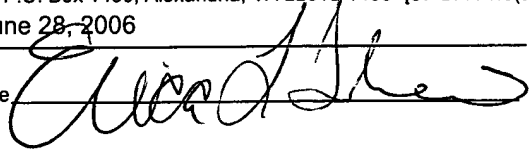




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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) NA11P091/01.049.01	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>June 28, 2006</u> Signature 		Application Number 09/935,635	Filed 08/24/2001
Typed or printed name <u>Erica L. Farlow</u>		First Named Inventor J. Green et al.	Art Unit 2143
		Examiner Neurauter, G.	

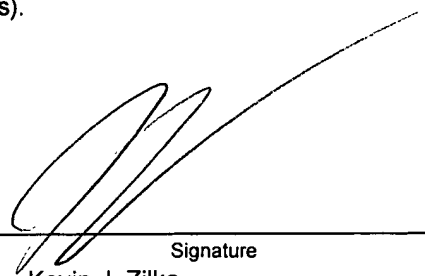
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record. 41,429
Registration number _____
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature
Kevin J. Zilka

Typed or printed name
(408) 971-2573

Telephone number
6/28/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

The Examiner has rejected Claims 29, and 37 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner has specifically argued that applicant's claimed "determining if the first file format is...a graphics file format type...the second file format being...the HTML file format type without scripts...if it is determined that the first file format is the graphics file format type" is not described in the specification to enable one to make and/or use the invention. Applicant respectfully points out paragraph [0025] in the specification, by way of example. Such excerpt discloses and enables converting a file with a graphics file format to an HTML file format and that an HTML file format (without scripts) is a safe format type.

In the Office Action mailed 04/18/2006, the Examiner argued that "the specification does not enable the conversion of a graphical file format to a HTML file format." Applicant asserts that the claimed technique to "determine if the first file format is one of a word processing format type and a graphics format type... the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type" (emphasis added), as claimed by applicant, is supported and enabled in the specification. Specifically, paragraph 0025 of the specification states "that the second file having the graphics file format will be converted to a JPB file format, a BMP file format, a JPEG file format, a GIF file format, or a HTML file format" (emphasis added). Additionally, paragraph 0025 of the specification states that "[i]n a further embodiment, the code is configured such that the server computer 122b converts every received electronic file, regardless of format, to one safe format, such as a HTML file format," which includes files of a graphics format type.

Regarding the Examiner's argument that "the HTML file format is a programming language that defines the structure of a document, not a graphical file," applicant respectfully asserts that HTML file formats are clearly capable of including graphics

information. Thus, there is nothing non-enabling with respect to applicant's claimed invention.

The Examiner has rejected Claims 1-3, 6, 8-9, 11-21, 23-34, 36-37 and 39-43 under 35 U.S.C. 102(b) as being anticipated by Ji et al. (U.S. Patent No. 5,889,943). Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, the Examiner has relied on Col. 11, line 14-Col. 12, lines 67, and specifically Col. 12, lines 47-49 and 56-67 in Ji to make a prior art showing of applicant's claimed "converting the electronic file from the first file format with the first file extension to a second file format with a second file extension that is different from the first file format with the first file extension and that prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient, said converting of the electronic file being in response to a determination that the electronic file represents at least the potential security risk to the computer system" (see the same or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that such excerpts only teach "transfer[ing] the mail message with the encoded portions...[with] the viruses deleted...[and] renam[ing] the encoded portions of the message containing viruses, [and] stor[ing] the renamed portions as files...and notify[ing] the user of the renamed files and directory path" (emphasis added). Thus, Ji teaches deleting the virus infected portions of a mail message or putting the virus infected portions in a new file and renaming the file. Clearly, since only portions of the file are renamed in Ji, such does not meet applicant's claimed "converting the electronic file." Furthermore, Ji only teaches that such infected portions are renamed and stored in files. Simply renaming a file does not meet any sort of converting the format of a file in the manner specifically claimed by applicant, and especially not where the conversion "prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient" (emphasis added), as claimed.

In the Office Action mailed 04/18/2006, the Examiner argued that ‘the conversion of the electronic file from a first file format to a second file format includes removing the virus from the attachment which may be in a graphical or word processing format and storing a “treated version” of the file in a format described in Ji as wherein the attachment is “completely cleaned” which includes “removing the virus from the message” and wherein “the infected attachment...may be replaced with the treated version”.’ However, merely cleaning the attachment and removing a virus from the message or replacing the infected attachment with the treated version simply fails to even suggest “converting the electronic file from the first file format with the first file extension to a second file format with a second file extension that is different from the first file format with the first file extension” (emphasis added), as claimed by applicant.

It appears that the Examiner is, in his arguments, relying on applicant’s specification to interpret the claimed term “conversion.” First, it is noted that applicant claims “converting,” not “conversion.” Further, in response to the Examiner’s proposed claim construction, applicant respectfully asserts that such term should be interpreted under its plain and ordinary meaning, as evidenced by the exemplary definition below, insofar as it is not inconsistent with the specification.

convert
n.

To change (something) into another form, substance, state, or product; transform: convert water into ice.

To change (something) from one use, function, or purpose to another; adapt to a new or different purpose: convert a forest into farmland.

*The American Heritage® Dictionary of the English Language, Fourth Edition
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However, even if the Examiner relies on the foregoing interpretation of the term “convert,” applicant respectfully asserts that the Examiner has still not taken into consideration the full weight and context of such claimed “converting,” as noted above. For example, the Examiner has admitted that “Ji discloses that the file retains its original format, the only difference being that the virus is removed.” Thus, by virtue of the Examiner’s own

admission that Ji's file retains its original format, Ji can not even suggest "converting the electronic file from the first file format with the first file extension to a second file format with a second file extension that is different from the first file format with the first file extension" (emphasis added), as claimed by applicant.

Also, the Examiner argued that "the claims do not specifically require how the electronic file formats are different from each other." The Examiner continued by 'interpret[ing] this difference wherein the first file format with a first file extension is infected with a virus and the second file format is the same file with the virus removed and is considered to be a "safe format" different from the infected format in accordance with the disclosures of the specification.' Again, applicant asserts that the Examiner's argument improperly dismisses applicant's claimed "converting the electronic file from the first file format with the first file extension to a second file format with a second file extension that is different from the first file format with the first file extension" (emphasis added), as claimed by applicant. Ji fails to disclose (especially in view of the Examiner's own admission above) that the second file extension is different from the first file extension, in the context claimed by applicant.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 21, the Examiner has relied on Col. 11, line 14-Col. 12, line 67 and specifically Col. 11, lines 48-52 in Ji to make a prior art showing of applicant's claimed "receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus; converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient; and making the converted second electronic file available for viewing by the another intended recipient."

Applicant respectfully asserts that such excerpt does not even suggest a file format, as claimed by applicant, but instead only relates to transmitting a message from the client to the

server. Applicant also points out the arguments made above with respect to the independent claims which clearly distinguish Ji from applicant's claim language.

With respect to Claims 23-27 et al., the Examiner has relied on Col. 13, lines 21-23; Col. 14, lines 30-38; and Col. 20, lines 22-29 in Ji to make a prior art showing of applicant's claimed "second file format being at least one of a TXT file format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GIF file format, a HTML file format without scripts, and a ASCII file format" (Claim 23 et al.); "second file format being the HTML file format without scripts (Claim 24 et al.); "second file format being the ACSII file format file" (Claim 25); "second file format being the TXT file format" (Claim 26); and "second file format being a file format having text without scripts" (Claim 27).

Applicant respectfully asserts that such excerpts only relate to the original format of the message, and not to a second file format in the context claimed by applicant, namely where the electronic file is converted from a first file format to the second file format, in the specific manners claimed.

With respect to Claim 29 et al., the Examiner has relied on Col. 13, lines 21-23; Col. 14, lines 30-38; and Col. 20, lines 22-29 in Ji to make a prior art showing of applicant's claimed "determining if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the certain file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, the HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type." Applicant again respectfully asserts that such excerpts only relate to an original format of the file, and do not even suggest any sort of converting a file from one format to another, let alone in the specific manner claimed by applicant.